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No. 442

IN THE

Supreme Court of the United States

October Term, 1968

MARVIN K. SWOFFORD, MARION F. WRIGHT AND ESSEX CORPORATION, d/b/a THE PATHFINDER COMPANY,

Petitioners,

v.

B & W, INC.
(And Reverse Title)

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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LIST OF AUTHORITIES

Cases

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A. & P. Tea Company v. Supermarket Corp. 340 US 147 4

STATUTES

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28 USC 2101(c) 1

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JURISDICTION

Title 28 USC Section 2101(c) provides as follows:

> "(c) Any other appeal or any writ of certiorari intended to bring any judgment or decree in a civil action, suit or proceeding before the Supreme Court for review shall be taken or applied for within ninety days after the entry of such judgment or decree. A justice of the Supreme Court, for good cause shown, may extend the time for applying for a writ of certiorari for a period not exceeding sixty days."

The judgment of the Court of Appeals in this action was entered May 22, 1968 [R.841]. The Petition for

Writ of Certiorari was not filed until August 26, 1968, being outside the ninety day period. Therefore the petition is not timely.

ARGUMENT IN GENERAL

This is an ordinary case for patent infringement, the District Court having held the patent in suit invalid and the Court of Appeals having affirmed, relying upon the decision of this Court in *Graham v. John Deere Co.* (1966) 383 US 1, both Courts being of the opinion that the subject matter was obvious in view of the state of the prior art under 35 USC 103. The only reason set forth in the petition for its allowance is the assertion by the petitioners that both the District Court and the Court of Appeals abused its discretion by not accepting a finding of fact by the jury as conclusive on the issue of obviousness. The petitioners' reasoning seems to be that the function of a court where a jury trial is involved is limited to acceptance of the jury's conclusion on the three conditions of patentability, i.e., novelty, utility and nonobviousness, and that in effect the jury is the proper group to determine whether or not a particular patent meets these conditions.

THE COURTS BELOW PROPERLY APPLIED THE LAW

This Court has repeatedly admonished the lower courts of the public interest involved in a determination of the validity of patents and has fully set forth the standards to be applied. As stated by this Court in *Graham v. John Deere Co.* (1966) 383 US 1 at page 17:

"Approached in this light, the § 103 additional condition, when followed realistically, will permit a more practical test of patentability. The emphasis on non-obviousness is one of inquiry, not quality, and, as such, comports with the constitutional structures.

"While the ultimate question of patent validity is one of law, *A. & P. Tea Co. v. Supermarket Corp., supra,* 340 US at 155, 95 L.ed. at 168, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. . . ."

The Fifth Circuit Court of Appeals in this case properly applied the test set forth above and held that the patent was invalid as a matter of law.

Assuming there was a conflict in the authorities prior to the decision of the *Graham v. John Deere Co.* case, *supra,* the Court of Appeals fully discusses and recognizes the alleged possible conflict and authorities relied upon by petitioners and the resolution of that conflict.

If the petitioners proposition were correct, no Court of Appeals could reverse a holding of a patent valid if the District Court found the subject matter to be non-obvious or, as in this instance, a jury found the asserted subject matter was not obvious. Such conclusion is con-

trary to the decision of this Court in *Graham v. John Deere Co., supra,* and in *A. & P. Tea Company v. Supermarket Corp.,* 340 US 147. Consequently, we suggest there is no conflict or confusion among the Courts in applying the fundamental principle of law since *Graham v. John Deere Co., supra,* and this is the only point in this case involving the public interest.

CONCLUSION

It is submitted that this case does not display any sufficient reason for the grant of a writ of certiorari. There is no important question of Federal law to be decided; this is merely a private suit between a patentee and an alleged infringer, and the public interest has been served by the holding of the District Court and the Court of Appeals that the patent in suit is invalid. It is suggested that the petition be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Service of this Respondent's Brief in Opposition to Petition for Writ of Certiorari has been made on petitioners by mailing, postage prepaid, to Jack W. Hayden, 1111-500 Jefferson Building, Houston, Texas 77002, on ....., 1968.

Attorneys for Respondent